

REMARKS

This is intended as a full and complete response to the Final Office Action dated December 17, 2002, having a shortened statutory period for response set to expire on March 17, 2003. Claims 15, 16, 26-28, and 30-39 are pending in the application and stand rejected. Please reconsider the claims pending in the application for reasons discussed below.

Claims 15, 16, 26-28, 30-32, 34, and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Delano* (U.S. Patent No. 4,100,968) in view of *Gjedebo* (WO 98/11322). The Examiner states that *Delano* discloses all of the limitations of the claims except for the gripping element (126 and 128) being radially displaced by hydraulic or pneumatic fluid directly applied thereto. The Examiner states that *Gjedebo* (WO 98/11322) teaches a gripping element (11 and 15) that is radially displaced by the direct application of hydraulic fluid. The Examiner, therefore, asserts that it would have been obvious to apply hydraulic or pneumatic fluid directly to the gripping element of *Delano* as taught by *Gjedebo* "in order to have had direct control over the amount of internal frictional connection between the element in the tubular."

Applicants respectfully traverse the rejection on grounds that the Examiner has not established a *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Further, the examiner must *particularly* identify any suggestion, teaching or motivation from within the references to combine the references (emphasis added). See *In Re Dembicza*k, 50 USPQ2d 1614 (Fed. Cir. 1999).

Here, the Examiner's stated motivation is not based on the references themselves, but based on the applicant's own disclosure. The Examiner asserts that *Gjedebo* teaches the use of hydraulic fluid with the gripping elements (11 and 15) "in order to have had direct control over the amount of internal frictional connection between the element in the tubular." The Examiner cited page 5, paragraph 4, lines 8 - 10, as support for this assertion. Applicant disagrees. At page 5, paragraph 4, lines 8-10, *Gjedebo* teaches that the catcher 11 can be "expanded to rest against the pipe, and

... establish an internal friction connection". *Gjedebo* does not teach or suggest using hydraulic fluid "to control the amount of an internal friction connection", as erroneously asserted by the Examiner. Accordingly, Applicants submit that the Examiner's assertion was based on the Applicants own disclosure, which is nothing more than impermissible hindsight. Hindsight is not a proper basis for an obviousness type rejection. Withdrawal of the rejection is respectfully requested.

Furthermore, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). *Delano* teaches a body that provides a plurality of frustoconical sections 124 which act to cam a plurality of slip segments 126, 128, outwardly upon manipulation of the control means 130. The slip segments 126, 128 are actuated by a mechanical force asserted thereon by a moveable piston 144, which makes up part of the control means 130. (See, *Delano* at Figure 3; col. 4, line 45 through col. 5, line15.) There is no reasonable expectation that the slip segments 126, 128 of *Delano* could be successfully replaced by the hydraulically activated catcher 11 of *Gjedebo* without adversely affecting its intended operability. Accordingly, withdrawal of the rejection and allowance of the claims is respectfully requested.

Claims 33, 37, and 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Delano* (U.S. Patent No. 4,100,968) in view of WO 98/11322 as applied to claims 31 and 32 above, and further in view of *Boyadejeff* (U.S. Patent No. 4,605,077) and *Albright et al.* (U.S. Patent No. 6,000,472). The Examiner states that *Delano* and WO 98/11322 disclose all of the limitations of the above claims except for the casing support being carried by pneumatically operated weight compensating pistons. The Examiner also states that it would have been obvious to have used the tubing support system of *Boyadejeff* in connection with the weight compensating pistons of *Albright et al.* with the pipe connecting device of *Delano* in view of WO 98/11322 in order to have been able to use the device with pipes of various lengths, thus weights, without overloading the system.

Applicants respectfully traverse the rejection. The arguments above regarding *Delano* in view of WO 98/11322 are equally applicable to this rejection. A combination

of the references, including *Boyadejeff* and *Albright et al.* do not teach, show or suggest at least one gripping element radially displaceable by pressurized fluid directly applied thereto, as recited in base claims 31, 36, and 39. Since claims 33 and 37 depend from base claims 31 and 36, respectively, claims 33 and 37 are patentable for at least the same reasons. Withdrawal of the rejection and allowance of the claims is respectfully requested.

In conclusion, the references cited by the Examiner, neither alone nor in combination, teach, show, or suggest the claimed invention. Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

The prior art made of record is noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, it is believed that a detailed discussion of the secondary references is not deemed necessary for a full and complete response to this office action. Accordingly, allowance of the claims is respectfully requested.

Respectfully submitted,



Robb D. Edmonds
Registration No. 46,681
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd., Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant(s)